



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,805	05/30/2001	Susumu Honma	109656	5667
25944	7590	05/13/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			KOROBOV, VITALI A	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 05/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

47

Office Action Summary

Application No.

09/866,805

Applicant(s)

HONMA ET AL.

Examiner

Vitali Korobov

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 are pending in this Office Action.
2. This action is in response to the applicant's amendment papers filed 03/04/2005.

Drawings

3. The corrected drawings were received on 03/04/2005. These drawings are accepted and previous objections to the drawings are hereby withdrawn.

Response to Arguments

4. Applicant's arguments, with respect to the rejection(s) of claim(s) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. The arguments presented by the Applicant are mute in view of these new ground(s) for rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1, 6, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 6, 9 recite such term as "page data",

“page data pieces” and “document data pieces”. These terms have ambiguous meaning in the art. During a personal interview, the Examiners pointed out this deficiency to the Applicant’s Representative and suggested providing appropriate clarification in the Applicant’s response to the First Office Action. No clarification was provided.

6. All dependent claims are rejected as having the same deficiencies as the claims they depend from.

Claim Rejection - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,819,301 issued to Rowe et al. (hereinafter Rowe), in view of U.S. Patent 5,191,611 issued to Lang (hereinafter Lang), and further in view of U.S. Patent 6,775,519 issued to Weideman et al., (hereinafter Weideman).

With respect to claim 1, Rowe teaches a document data transmission device comprising: storage means for storing plural document data pieces including one or plural page data pieces (Col. 25, lines 19 – 22 – storage of documents on server; col. 26, lines 36 – 37 – storage on server of a plurality of documents; col. 26, lines 7 – 9 – documents may contain plurality of pages); page data transmission request receiving

Art Unit: 2155

means for receiving a page data transmission request transmitted from a user terminal (Col. 25, lines 10 – 13 – downloading (transmission) request receiving means), requesting to transmit specific page data (Col. 4, lines 9 – 12, col. 26, lines 45 – 49) contained in specific document data selected among the plural document data pieces stored in the storage means (Col. 25, lines 15 – 19 – “finder” performs the selection of the document). In col. 2, lines 4 – 8, Rowe recites retrieval of documents through globally-accessible means, but fails to explicitly teach transmission of data to a user through a satellite network. Lang teaches satellite communications network (Col. 11, lines 16 – 20). Rowe and Lang are analogous art, because they are both related to transmitting data to a user in response to user’s request. Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine selective page download capabilities of Rowe with satellite transmission capabilities of Lang in order to further enhance global accessibility of users to documents (Rowe, col. 2, lines 4 – 8). This obvious combination of Rowe and Lang would provide page data transmitting means for transmitting the specific page data contained in the specific document data (Rowe, col. 4, lines 9 – 12) to the user terminal through a satellite network (Lang, col. 11, lines 26 – 29), on the basis of the page data transmission request received by the page data transmission request receiving means (Rowe, col. 26, lines 45 – 49).

With respect to claim 2, Rowe/Lang combination teaches the document data transmission device according to claim 1 (see above), wherein the storage means stores plural summary data pieces including contents information of each of the plural

Art Unit: 2155

document data pieces (Lang, col. 11, lines 10 – 16, message/document summary list), the document data transmission device further comprising: summary data transmission request receiving means for receiving summary data transmission request transmitted from the user terminal (Lang, col. 11, lines 10 – 13) requesting to transmit a specific summary data selected among the plural summary data pieces stored in the storage means (Rowe, Fig. 2a, bookmark view of a selected document); and summary data transmitting means for transmitting the specific summary data to the user terminal, on the basis of the summary data transmission request received by the summary data transmission request receiving means (Rowe, col. 25, lines 15 – 18 – “finder” and Fig. 2a and 2b – viewer, provide the means for transmitting to the user the specific summary data to the user terminal).

With respect to claim 3, Rowe/Lang combination teaches the document data transmission device according to claim 2, but fails to explicitly teach further limitations of claim 3. Weideman teaches a satellite communication system for connecting user terminal to a data communications network for retrieving specific “units of information”, comprising billing amount calculating means for calculating a billing amount charged to a transmission of the page data and to a transmission of the summary data, on the basis of a unit price charged to a transmission of a unit data quantity of the page data and a unit price charged to a transmission of a unit data quantity of the summary data (Col. 11, lines 59 – 67, col. 12, lines 1 – 7). Rowe, Lang and Weideman are analogous art, because they are related to transmitting data to a user in response to user’s request. Therefore, it would have been obvious to one having ordinary skills in the art at

Art Unit: 2155

the time the invention was made to combine selective page download capabilities of Rowe and Lang with per page billing features of Weideman in order to provide an improved method and apparatus for accounting for system usage in a connectionless type of satellite communication system, to provide an improved method and apparatus for accounting for session-based system usage in a satellite communication system wherein users employ IP or other types of protocols, and to provide an improved method and apparatus for aggregating system usage data for billing system service providers (Weideman, col. 2, lines 16 – 27).

With respect to claim 4, it is rejected in view of the above rejection of claim 1 and further in view of Weideman, who teaches a satellite communications system comprising a user terminal (Col. 3, line 20) for transmitting a page data transmission request requesting to transmit the specific page data to the document data transmission device (Weideman, col. 3, lines 14 – 22), and receiving the specific page data transmitted from the document data transmission device through a satellite network (Fig. 1).

With respect to claim 5, it is rejected in view of the above rejection of claim 2 and further in view of Lang, who teaches a user terminal for transmitting a summary data transmission request requesting to transmit the specific summary data to the document data transmission device (Lang, col. 11, lines 10 – 13), and receiving the specific summary data transmitted from the document data transmission device (Lang, col. 11, lines 13 – 20).

The Examiner was impressed by the Applicant Representative's adept writing skills exhibited in presenting independent claims 4 and 5 as dependent claims of claims 1 and 2, respectively. This Office will contact the Applicant's Representative regarding collection of additional fees for claims 4 and 5 separately.

Claims 6 – 8 are rejected in view of the above rejection of claims 1 – 5, because claims 6 – 8 are essentially the same as claims 1 - 5, except that said claims 6 – 8 set forth the invention as a document data transmission method rather than a document data transmission apparatus or system, as do claims 1 - 5.

With respect to claim 9, the Rowe/Lang/Weideman teaches a document data transmission device comprising: storage means for storing plural document data pieces including one or plural page data pieces (Rowe, col. 25, lines 19 – 22 – storage of documents on server; col. 26, lines 36 – 37 – storage on server of a plurality of documents; col. 26, lines 7 – 9 – documents may contain plurality of pages) and plural summary data pieces including contents information of each of the plural document data pieces (Lang, col. 11, lines 10 – 16, message/document summary list), page data transmission request receiving means for receiving a page data transmission request transmitted from a user terminal (Rowe, Col. 25, lines 10 – 13 – downloading (transmission) request receiving means), requesting to transmit specific page data (Rowe, Col. 4, lines 9 – 12, col. 26, lines 45 – 49) contained in specific document data selected among the plural document data pieces stored in the storage means (Rowe, Col. 25, lines 15 – 19 – “finder” performs the selection of the document), page data transmitting means for transmitting the specific page data contained in the specific

Art Unit: 2155

document data (Rowe, col. 4, lines 9 – 12) to the user terminal through a satellite network (Weiderman, Fig. 1, satellites 12, user terminals 13), on the basis of the page data transmission request received by the page data transmission request receiving means (Weiderman, col. 3, lines 20 – 22), summary data transmission request receiving means for receiving a summary data transmission request transmitted from the user terminal (Lang, col. 11, lines 10 – 13), requesting to transmit specific summary data selected among the plural summary data pieces stored in the storage means (Rowe, Fig. 2a, bookmark view of a selected document), and summary data transmitting means for transmitting the specific summary data to the user terminal, on the basis of the summary data transmission request received by the summary data transmission request receiving means (Rowe, col. 25, lines 15 – 18 – “finder” and Fig. 2a and 2b – viewer, provide the means for transmitting to the user the specific summary data to the user terminal).

With respect to claim 10, the Rowe/Lang combination teaches the document data transmission device of claim 1, wherein the page data transmission request is transmitted from the user terminal to the page data request receiving means via a ground-based network (Rowe, col. 34, lines 62 – 67, ground-based network World Wide Web).

With respect to claim 11, the Rowe/Lang combination teaches the document data transmission device of claim 10, wherein the ground-based network comprises the Internet (Rowe, Col. 2, col. 8 – 13 - Internet).

With respect to claim 12, the Rowe/Lang combination teaches the document data transmission device of claim 1, wherein each of the plural document data pieces comprises a plurality of page data pieces (Rowe, Col. 25, lines 19 – 22 – storage of documents on server; col. 26, lines 36 – 37 – storage on server of a plurality of documents; col. 26, lines 7 – 9 – documents may contain plurality of pages).

With respect to claim 13, the Rowe/Lang combination teaches the document data transmission device of claim 12, wherein each page data piece corresponds to at least one of data to be printed out on a single sheet of recording paper and data to be viewed on a single screen of a display (Rowe, Col. 25, lines 47 – 50, col. 26, lines 45 – 49 – page viewing and downloading).

With respect to claim 14, the Rowe/Lang combination teaches the document data transmission device of claim 1, wherein the plural page data pieces comprise at least one of text data and picture data (Rowe, Fig. 2a, item 42 – text, Fig. 2b, picture icons 50).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

U.S. Patent No. 4,450,477 by Lovett. The patent is considered pertinent to the applicant disclosure because it teaches a method and system wherein the information provider charges a user a per-page access fee.

U.S. Patent No. 6,449,639 by Blumberg. The patent is considered pertinent to the applicant disclosure because it teaches a method and system for viewing a document containing at least one page and at least one image, the document being located on a server computer, including sending by a client computer a page display request to the server computer system.

U.S. Patent No. 4,571,700 by Emry, Jr. et al. The patent is considered pertinent to the applicant disclosure because it teaches a page indexing system for accessing sequentially stored data representing a multi-page document.

U.S. Patent No. 6,687,878 by Eintracht et al. The patent is considered pertinent to the applicant disclosure because it teaches a system wherein a single page of a multipage document can be annotated on a notes client without requiring the entire multipage document to be transmitted

U.S. Patent No. 6697850 by Saunders. The patent is considered pertinent to the applicant disclosure because it teaches a satellite-based communications system having an on-board internet web proxy cache. If the request is made from a standard terminal, the satellite relays the request for a web page directly to the ground station, which retrieves the requested web page from a local cache or the internet, and transmits the requested web page to the satellite, where the satellite in turn retransmits it to the user terminal.

Art Unit: 2155

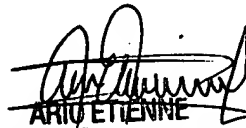
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vitali Korobov
Examiner
Art Unit 2155

05/11/2005


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100